



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,442	05/05/2004	Eric P. Berg	NHPager	3441

7590 09/26/2005
Mark R. Winser
Winser & Associates
1177 West Loop South, Suite 400
Houston, TX 77027-9012

EXAMINER

BANGACHON, WILLIAM L

ART UNIT PAPER NUMBER

2635

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/709,442

Applicant(s)

BERG, ERIC P.

Examiner

William Bangachon

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☒ Claim(s) 17-19, 23-27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 May 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Examiner's Response

1. In response to the application filed 5/5/2004, the application has been examined. The Examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. It is the Examiner's position that **claims 1-29** are unpatentable for the reasons set forth in this Office action:

Information Disclosure Statement

2. It is noted that there is no IDS filed with this application. The listing of references in the specification [0005] is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the Examiner on form PTO-892 has cited the references, they have not been considered.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the **"paging transmitter and receiver"** recited in claims 2, 3, 12, 21 and 28-29; the **"display**

Art Unit: 2635

device” recited in claims 9, 17 and 27, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the Examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities:

A reference to the prior application must be inserted as the first sentence(s) of the specification of this application. The reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the

Art Unit: 2635

application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was

Art Unit: 2635

unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11. Appropriate correction is required.

Double Patenting

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101, which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 17-19, 27 and 23-26 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 4, 9-10 and 13-16. When two claims in an application are duplicates or else are so close in content that they both cover the same thing,

Art Unit: 2635

despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 09/910,414 in view of USP 5,668,538 {Warwick}. Although claims 1-4 of application '414' do not disclose an **input electrical supply source and standard and/or plurality of electrical outlets**, these claim limitations would have been obvious in '414' because it is directed to electrical power metering system which would eventually have a electrical outlets when connected to a home, to one of ordinary skill in the art. As evidenced by Warwick, the input electrical supply source is that part of the meter that is connected to the main power supply line and the output electrical outlet is that part of the meter that is connected to homes, being supplied with power and read by the meter {see whole document}.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1 and 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 6,380,852 {Hartman et al}.

In claim 1, Hartman et al teach of a system for remote operation of devices (117) {Summary or the invention}, said system comprising:

an input electrical supply source (82) {col. 6, lines 40-46};

an output electrical outlet (80) {col. 6, lines 27-39};

a switching circuit (84) connected between said input electrical supply source (82) and said output electrical outlet (80) {col. 6, lines 47-52};

a receiver (86) for receiving control signals from a remote source (90) {col. 6, lines 56-64}; and

a processor (272) for processing said control signals from said receiver (86) to open said switching circuit (84) to interrupt electrical power transmission between said input electrical supply source (82) and said output electrical outlet (80) {col. 7, lines 52-65}.

In claim 4, the system of claim 1 wherein said system further includes:

an enclosure (102); and

said output electrical outlet (80); said processor and said receiver are mounted within said enclosure (102) as shown in figure 1.

In claim 5, the system of claim 1 wherein supply said input electrical source includes:

a power cord (wire connected to 82); and

a plug-in connected to 82 (as shown in figure 1) for insertion in a standard electrical wall outlet.

In claim 6, the system of claim 1 wherein said output electrical outlet includes:

a standard electrical outlet (80) for receiving a standard plug-in from a power cord of an electrical device such as a vacuum cleaner (117).

In claim 7, the system of claim 1 wherein said system includes:

a plurality of output electrical outlets (80). Two are shown in figure 1. Also see col. 14, lines 50-62.

13. Claims 2-3, 9 and 28, are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 6,380,852 {Hartman et al} in view of USP 5,608,655 {Moughanni et al}.

In claim 2, Hartman et al do not disclose expressly a paging receiver for receiving control signals. As evidenced by Moughanni, in the same field of endeavor (remote control systems), remote control using a pager provides a person at a distance away from his home, an immediate link to his home or appliances, such as turning the air-conditioner or heater to ON/OFF {Moughanni, col. 1, lines 63+; col. 2, lines 49-63}. Obviously, these features are beneficial in the system of Hartman, in case a person forgets to turn the air-conditioner or heater ON/OFF before the person left his home. Hartman teaches that the remote transmitter (RF or IR) can be built into other types of transmitting devices, such as telephone devices {Hartman, col. 13, lines 29-36}, or other types or transmitters {Hartman, col. 11, lines 7-8}. Obviously, a pager device as taught by Moughanni, would have been obvious in the transmitter of Hartman because it allows the pager transmitter to control the switchable power receptacle of Hartman at a distance, to one of ordinary skill in the art.

In claim 3, said system further includes a decoder processor (Moughanni, 14) to decode the signal received from said radio frequency receiver from said paging transmitter into a control signal for said processor.

In claim 9, the system of claim 1 wherein said processor further includes means for sending a message to be displayed on a display device {Hartman, col. 9, lines 4+}. In this case, the flashing LED is an obvious variation of a display device because it allows visual confirmation, to one of ordinary skill in the art.

Claim 28 recites the combination of claims 1-3 and therefore rejected for the same reasons.

14. Claims 8, 10-27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 6,380,852 {Hartman et al} and USP 5,608,655 {Moughanni et al}, and further in view of USP 5,265,154 {Schotz, col. 2, lines 13-30}.

With regards to claims 8, 10, 18, 20 and 22, Hartman teach of a telephone ring detector {col. 10, lines 22+}. Hartman do not disclose expressly a telephone or telecommunications disconnecting system. In this case, Schotz, in the same problem solving area, teach of a telephone controller apparatus {Schotz, col. 2, lines 13-29} for connecting and disconnecting a telephone line as claimed, which includes (see Schotz);

an input telephone source for receiving a telephone signal (line 20);

an output telephone outlet (14);

a telephone switching circuit (Fig. 3B, relay 211) mounted between said input telephone source and said output telephone outlet; and

said telephone switching circuit is operable under command signals from said processor based on said receiver to interrupt and connect signal transmission between said input telephone source and said output telephone outlet {Schotz, col. 2, lines 13-29}.

Hartman and Schotz are in the same problem solving area because they are both concerned with providing a system for disconnecting a telephone line located in a room, so as not to disturb the occupants or a child in the room {Hartman, col. 1, lines 39-42; Schotz, col. 1, lines 20-30}.

Therefore, it would have been obvious to one of ordinary skill in the art to have a telephone or telecommunications disconnecting system, as claimed, in the system of Hartman, as taught by Schotz, because it allows the system of Hartman to disconnect a telephone line located in a child's room, so as not to disturb the child in the room.

Claims 11 and 20 recite the combination of claims 1 and 8 and therefore rejected for the same reasons.

In claims 12 and 21, said system further includes a decoder processor (Moughanni, 14) to decode the signal received from said radio frequency receiver from said paging transmitter into a control signal for said processor.

In claims 13, 19 and 23, wherein said system further includes:

an enclosure (102); and

said output electrical outlet (80); said processor and said receiver are mounted within said enclosure (102) as shown in figure 1.

In claims 14 and 24, said input electrical supply source includes:

Art Unit: 2635

a power cord (wire connected to 82); and

a plug-in connected to 82 (as shown in figure 1) for insertion in a standard electrical wall outlet.

In claims 15 and 25, said output electrical outlet includes:

a standard electrical outlet (80) for receiving a standard plug-in from a power cord of an electrical device such as a vacuum cleaner (117).

In claims 16 and 26, said system includes:

a plurality of output electrical outlets (80). Two are shown in figure 1. Also see col. 14, lines 50-62.

In claims 17 and 27, said processor further includes means for sending a message to be displayed on a display device {Hartman, col. 9, lines 4+}. In this case, the flashing LED is an obvious variation of a display device because it allows visual confirmation, to one of ordinary skill in the art.

Claim 29 recites the combination of claims 1-3 and 10 and therefore rejected for the same reasons.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 6,785,383 {Fan et al} is cited in that it teaches a telephone line switch recited in claims 8 and 10. See whole document.

Office Contact Information

16. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to William Bangachon whose telephone number is **(571)-272-3065**. The Examiner can normally be reached on 4/4/10.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Michael Horabik can be reached on **(571)-272-3068**. The fax phone numbers for the organization where this application or proceeding is assigned is **571-273-8300** for regular and After Final formal communications. The Examiner's fax number is **(571)-273-3065** for informal communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Application/Control Number: 10/709,442
Art Unit: 2635

Page 14



William L. Bangachon
Examiner
Art Unit 2635

September 20, 2005

MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

